



Patent US 211
Attorney Docket: 895,080-008

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Board of Patent Appeals and Interferences

In re the Application of:

Stuart Berman

Serial No.: 09/330,755

Filed: June 11, 1999

For: FIBRE CHANNEL SWITCHING SYSTEM

Group Art Unit: 2665

Examiner: Daniel J. Ryman

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REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant respectfully and forcefully submits that the rejections of the claims must be reversed. The rejections are neither factually supported nor is the proper legal standard applied.

The base reference (Bennett) is factually misdescribed in the Answer when it is said to include overrun prevention (Answer, p. 3, three lines from the bottom). What Bennett does describe is a very limited and particular solution to Bennett's very particular problem i.e., that fibre channel frames were 2148 bits long, but that the particular buffer Bennett used was only 2096 bits long -- the solution to the possible overflow was to include an additional buffer.¹ In a colloquial manner, if the incoming bucket (buffer) is too small, add a second bucket.

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~~Adjustment date: 07/20/2004 HLE333~~
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¹ The overflow buffer is buffer 0 (col. 5, ln. 65).

CERTIFICATE OF MAILING (37 C.F.R. §1.8a)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to the Mail Stop Appeal Briefs - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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The Answer moves at page 4 to Gulick and incorrectly applies an ‘obvious to try’ argument. The Examiner’s statement that “an obvious place to locate” (the logic) misstates the legal test, that is, whether the combination of claim elements as a whole would have been obvious to one of ordinary skill in the art given the teachings of the references.

The combination of Bennett and Gulick simply cannot be made. To continue with the colloquial analogy, Bennett tells you to use two buckets if one isn’t big enough, and Gulick tells you to dump out the bucket if a particular event (overflow) happened. There can be no true suggestion to combine where two teachings are diametrically opposite.

The addition of Lowell does not solve this fatal defect. The Answer states that Lowell discloses “a variety of overflow buffer configurations”. (Answer at p. 4, line 9). Which of these are we to pick? Again, at best, this presents the “obvious to try” issue. At worst, there was no teaching or suggestion to combine the contradictory teachings of Bennett and Gulick, there is truly no teaching or suggestion to graft on the Lowell’s laundry list of configurations.

For the reasons set forth in the Appeal Brief and this Reply Brief, Applicants request that the rejections be reversed and all claims allowed.

Request for Oral Hearing

Applicants reiterate their requests for an Oral Hearing, previously requested and paid for with the Appeal Brief submission.

Fees & Miscellaneous

The Commissioner is hereby authorized to charge Deposit Account No. 50-2862 for requisite fee of **\$165.00** for filing a Reply Brief.

Respectfully submitted,

O'MELVENY & MYERS LLP

Dated: 7/12/04

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